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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,931	04/28/2005	Gerhard Hamprecht	3165-121	3101

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WASHINGTON, DC 20005

EXAMINER

SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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11/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

DETAILED ACTION

Status of the Claims

Claims 1-21 are pending.

Claims 1-17 and 19 have been withdrawn in view of the election.

Claims 18 and 20-21 were previously elected and currently pending.

Claim Rejections - 35 USC § 102

The rejection of claim 18 under 35 U.S.C 102(b) has been withdrawn.

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 20 and 21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsen et al., WO 01/83459 A2 for the reasons set forth in the previous office action mailed on 03/20/09.

Response to Amendment/Remarks

Applicant's arguments filed on 07/20/09 have been fully considered but they are not deemed persuasive. Applicants argue that Carlsen does not teach or suggest a synthetic process which can or should begin with a nitro compound or that the reaction can proceed efficiently using an acid halide or ester 3-nitro reactant. In response, applicants should note that it is well settled that consideration of a reference is not limited to the preferred embodiments, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art to one skilled in the art. Note as previously stated, Carlsen employs the use of analogous reactants.

Additionally, applicant's argument that the specific combination of substituents in claim 18 cannot be derived from Carlsen appears to be misguided because the compound cannot simply be willed out of existence since it is the only compound made which embraces formula (II). Moreover, the process steps, different from the current invention cannot be deemed inventive simply because the "order" of reaction is **not** the same. Applicants have not provided any evidence to support the notion that the compound made by Carlsen cannot be used as a *precursor* for the preparation of crop

Art Unit: 1624

protection agents. A mere argument or conclusionary statement by applicants will not suffice. Note *Geisler*, 116 F. 3d at 1470, 43 U.S.P.Q. 2d at 1365.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

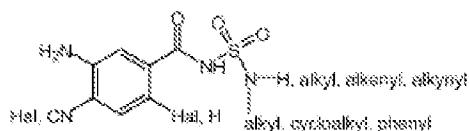
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsen et al., WO 01/83459.

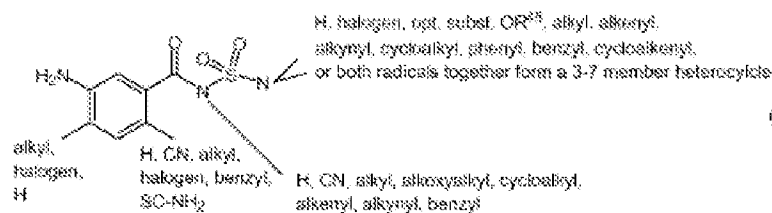
Applicant's claim compounds of structural formulae shown in claims 18 and 22



Determination of the scope and content of the prior art (MPEP §2141.01)

Carlsen et al., teach compounds structurally similar to the currently claimed compounds.

See the entire reference especially page 38, where Ar is substituted phenyl, X^2 is hydrogen, where X^1 is hydrogen or CH_3 etc,



Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the current compounds and Carlsen et al., is that Carlsen teaches compounds which generically embraces the current compounds as noted the various definitions of the substituents.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2143)

Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of filing the instant application to prepare additional compounds from under the genus of “459”, especially where ‘459’ prefers certain embodiments such as where Ar is substituted phenyl with the expectation that said compounds would have the same or similar activity. See *In re Baird*, 146 USPQ 579 (CCPA 1965).

One of ordinary skill in the art would have found the claimed compounds *prima facie* obvious, since the claimed compounds in ‘459’ generically embrace them. The requisite motivation for arriving at the claimed compounds stems from the fact that they fall within the generic class of compounds disclosed by ‘459’. Accordingly, one of ordinary skill would have been motivated to prepare any of the compounds embraced by the disclosed generic formula, including those encompassed by the claims, with the expectation that each of them would be suitable as a precursor to crop protection agents.

Note that the disclosed compounds have pharmaceutical activity, thus the skilled artisan would expect such structurally similar compounds to possess similar properties. Additionally, the Court stated in *In re Payne et al.*, 606 F.2d 302, 203 USPQ at 255 (CCPA 1979):

“the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound.”

Furthermore, any question of why would one conceive and use the similar compounds (i.e., motivation) is answered by the Court in *In re Gyurik et al.*, 596 F.2d 1012, 201 USPQ 552 at 557:

“In obviousness rejections based in close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the *prima facie* case of obviousness, rises from the expectation that compounds similar in structure will have similar properties” in anti-tumor activity.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EBENEZER SACKKEY whose telephone number is (571)272-0704. The examiner can normally be reached on 7.30-4.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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